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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/436,513	11/09/99	JONES	J 3290.007US1
			EXAMINER
020227 HM12/0817 MAJESTIC PARSONS SIEBERT & HSUE SUITE 1100 FOUR EMBARCADERO CENTER SAN FRANCISCO CA 94111-4106			PATTERSON, C ART UNIT PAPER NUMBER 1652

DATE MAILED: 08/17/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-62 is/are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-62 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-20 and 51-62, drawn to a modified serine hydrolase and a method of making, classified in Class 435, subclass 221.

II. Claims 21-30 and 43-50, drawn to a method of forming a peptide bond incorporating an amino acid into a polypeptide, classified in Class 435, subclass 69.1.

III. Claims 31-37, drawn to a method of resolving racemic alcohols, classified in Class 435, subclass 280.

IV. Claims 38-42, drawn to a method of attaching a chiral moiety to a substrate, classified in Class 435, subclass 135.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and (II-IV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product as claimed can be used in a materially different process. The modified enzyme can be used in any of the different methods of Groups II - IV to make different substances.

Groups II - IV are drawn to method of making different substances and therefore are patentably distinct.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.


Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., Ph.D. whose telephone number is (703) 308-1834. The examiner can normally be reached on any day of the week from 7:30 AM until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached on (703) 308-3804. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Patterson
August 15, 2000


CHARLES L. PATTERSON, JR.
PRIMARY EXAMINER
GROUP 1800